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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,391	07/01/2003	Susan Hickey	100041-41143	1534
7590 01/12/2006				
Mark P. Levy, Esq. Thompson Hine LLP 2000 Courthouse Plaza NE 10 W. Second Street Dayton, OH 45402-1758		EXAMINER GREEN, BRIAN		
		ART UNIT		PAPER NUMBER
		3611		

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,391	Applicant(s) HICKEY ET AL.	
	Examiner Brian K. Green	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 28, 29 and 38-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 28, 29 and 38-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Oct. 7, 2005 has been entered.

Claim Rejections - 35 USC § 112

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is indefinite since it is not clear whether the anti-static electric property or a reduced static electricity is the same as the one defined in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4-14,16,28,29,39,42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and

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Scianna (U.S. Patent No. 5,997,995) and Savit (U.S. Patent No. 4,454,058) or the applicant's admitted prior art in the remarks section of the amendment filed on Nov. 19, 2004, page 11, lines 4-12.

G.B. '520 shows in figures 1-5 a mouse pad that includes a plurality of stacked sheets (block of sheets labeled 1) wherein each adjacent sheet is joined to another adjacent sheet along at least two separate edges. G.B. '520 discloses on page 1, three lines from the bottom, the idea of placing a calendar on each of the stacked sheets. G.B. '520 does not disclose whether the calendar portion has a time period of at least one week and the idea of placing on the upper surface of the sheets an anti-static electric property. Glass shows in figure 1 the idea of placing a calendar portion (month of January) that includes a time period of at least one week. In view of the teachings of Glass it would have been obvious to one in the art to modify G.B. '520 by placing a calendar portion having a time period of at least one week onto each of the sheets since this would allow an entire month to be displayed by a single sheet which would make the sheets more useful. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce the static on the paper by increasing the surface-conductivity of a substrate. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets since this would reduce the amount of static electricity stored on the sheets which would help to prevent damage to electrical components and accumulation of

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dust and dirt. In regard to claim 2, the sheets of G.B. '520 are made out of paper and are considered to have a charge of less than 10 volts when the mouse pad is grounded (a persons hand resting on the pad, the pad resting on a metal surface, etc.), when it hasn't been used for an extended period of time the mouse pad would have little or no charge, and in view of the fact that the sheet has been modified to include an anti-static coating. In regard to claims 4 and 6, the sheets are generally rectangular with rounded corners and are adhered together with adhesive along three edges, see figures 4 and 5. In regard to claims 5 and 11, Glass discloses the idea of placing different calendar portions on each sheet, see page 1, column 2, lines 36-47. In regard to claim 7, the adhesive used is inherently weaker than the sheets since the sheets are separated from one another without damaging the sheets, see figure 5. In regard to claim 8, as broadly defined, the adhesive is considered to be the binding means. In regard to claim 9, G.B. '520 in view of Glass disclose the applicant's basic inventive concept except for making the resistivity of each sheet between 800 and about 3000 ohms. G.B. '520 fails to disclose the resistivity of the sheets but does disclose that the sheets are made from paper. Paper inherently has a high resistivity since it is an insulator. Paper would have a resistivity higher than the range specified by the applicant. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce the static on the paper by increasing the surface-conductivity of a substrate. Increasing the surface conductivity would reduce the resistivity of the paper sheets of G.B. '520. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior

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art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets (which would reduce the resistivity) since this would reduce the amount of static electricity stored on the sheets and would provide a resistivity of between about 800 and about 3000 ohms. It is considered within one skilled in the art to vary the conductivity of the coating, and hence the resistivity, to reach the desired level. In regard to claim 10, the sheets of G.B. '520 are generally aligned. In regard to claims 12 and 13, Glass discloses that each sheet includes a month of the year in order, see page 1, column 2, lines 36-47. In regard to claim 14, G.B. '520 shows a backing pad (2). In regard to claim 16, Savit and the applicant's admitted prior art disclose the idea of making the anti-static material in the form of a coating. In regard to claims 28 and 48, the steps defined are the conventional steps that are followed in using a mouse pad, i.e. locating a computer mouse onto the mouse pad, moving said mouse along the pad to cause movement of a cursor on a computer display. In regard to claims 29 and 39, G.B. teaches the idea of removing a top sheet to expose another sheet, see page 2, fourth new paragraph which starts with "Referring". In regard to claim 39, the uppermost sheet would be removed from the stack of sheets at the end of the calendar period, this is the conventional manner in which calendars of the type taught by Glass are used. In regard to claims 42 and 43, the sheets of GB '520 are made out of paper.

Claims 3,38,40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and Scianna (U.S. Patent No. 5,997,995) and Savit (U.S. Patent No. 4,454,058) or the applicant's admitted prior art in the remarks section of the amendment filed on Nov. 19, 2004, page 11, lines 4-12 as applied to claim

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1 above and further in view of Chasnoff (U.S. Patent No. 6,789,340) or Voy et al. (U.S. Patent No. 5,351,426) or Carpenter (U.S. Patent No. 2,030,135).

G.B. '520 in view of Glass and Scianna and Savit or applicant's admitted prior art disclose the applicant's basic inventive concept except for placing adhesive only on the corners of the sheets. Chasnoff shows in figures 1-5 the idea of attaching adhering components (12) only on the corners of the sheet, see column 3, lines 30-35. Voy et al. shows in figure 12 the idea of attaching adhesive (705) only on the corners of a label. Carpenter shows in figure 5 the idea of only placing adhesive (11) on the corners of a display sheet. In view of the teachings of Chasnoff or Voy et al. or Carpenter it would have been obvious to one in the art to modify G.B. '520 by placing the adhesive only in the corners of the sheets since this would allow each sheet to be grasped and removed in an easier and more convenient manner.

Claims 44-46,48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and Chasnoff (U.S. Patent No. 6,789,340) or Voy et al. (U.S. Patent No. 5,351,426) or Carpenter (U.S. Patent No. 2,030,135).

G.B. '520 shows in figures 1-5 a mouse pad that includes a plurality of stacked sheets (block of sheets labeled 1) wherein each adjacent sheet is joined to another adjacent sheet along at least two separate edges. G.B. '520 discloses on page 1, three lines from the bottom, the idea of placing a calendar on each of the stacked sheets. G.B. '520 does not disclose whether the calendar portion has a time period of at least one week and the idea of only placing the adhesive on the corners of the sheets. Glass shows in figure 1 the idea of placing a calendar portion

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(month of January) that includes a time period of at least one week. In view of the teachings of Glass it would have been obvious to one in the art to modify G.B. '520 by placing a calendar portion having a time period of at least one week onto each of the sheets since this would allow an entire month to be displayed by a single sheet which would make the sheets more useful.

Chasnoff shows in figures 1-5 the idea of attaching adhering components (12) only on the corners of the sheet, see column 3, lines 30-35. Voy et al. shows in figure 12 the idea of attaching adhesive (705) only on the corners of a label. Carpenter shows in figure 5 the idea of only placing adhesive (11) on the corners of a display sheet. In view of the teachings of Chasnoff or Voy et al. or Carpenter it would have been obvious to one in the art to modify G.B. '520 by placing the adhesive only in the corners of the sheets since this would allow each sheet to be grasped and removed in an easier and more convenient manner.

Claims 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and Chasnoff (U.S. Patent No. 6,789,340) or Voy et al. (U.S. Patent No. 5,351,426) or Carpenter (U.S. Patent No. 2,030,135) as applied to claims 47 and 50 above and further in view of Scianna (U.S. Patent No. 5,997,995) and Savit (U.S. Patent No. 4,454,058) or the applicant's admitted prior art in the remarks section of the amendment filed on Nov. 19, 2004, page 11, lines 4-12.

G.B. '520 does not disclose the idea of placing on the upper surface of the sheets an anti-static electric property. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce

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the static on the paper by increasing the surface-conductivity of a substrate. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets since this would reduce the amount of static electricity stored on the sheets which would help to prevent damage to electrical components and accumulation of dust and dirt.

Claims 1,2,4-14,16,28,29,39,42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and Incorvia et al. (U.S. Patent No. 6,187,856).

G.B. '520 shows in figures 1-5 a mouse pad that includes a plurality of stacked sheets (block of sheets labeled 1) wherein each adjacent sheet is joined to another adjacent sheet along at least two separate edges. G.B. '520 discloses on page 1, three lines from the bottom, the idea of placing a calendar on each of the stacked sheets. G.B. '520 does not disclose whether the calendar portion has a time period of at least one week and the idea of placing on the upper surface of the sheets an anti-static electric property. Glass shows in figure 1 the idea of placing a calendar portion (month of January) that includes a time period of at least one week. In view of the teachings of Glass it would have been obvious to one in the art to modify G.B. '520 by placing a calendar portion having a time period of at least one week onto each of the sheets since this would allow an entire month to be displayed by a single sheet which would make the sheets more useful. Incorvia et al. discloses in column 1, lines 1-20-50 the idea of adding an anti-static

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element to a sheet. In view of the teaching of Incorvia et al. it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets since this would reduce the amount of static electricity stored on the sheets which would help to prevent the accumulation of dust and dirt as taught to be desirable by Incorvia et al., column 1, lines 45-48. In regard to claim 2, the sheets of G.B. '520 are made out of paper and are considered to have a charge of less than 10 volts when the mouse pad is grounded (a persons hand resting on the pad, the pad resting on a metal surface, etc.), when it hasn't been used for an extended period of time the mouse pad would have little or no charge, and in view of the fact that the sheet has been modified to include an anti-static coating. In regard to claims 4 and 6, the sheets are generally rectangular with rounded corners and are adhered together with adhesive along three edges, see figures 4 and 5. In regard to claims 5 and 11, Glass discloses the idea of placing different calendar portions on each sheet, see page 1, column 2, lines 36-47. In regard to claim 7, the adhesive used is inherently weaker than the sheets since the sheets are separated from one another without damaging the sheets, see figure 5. In regard to claim 8, as broadly defined, the adhesive is considered to be the binding means. In regard to claim 9, G.B. '520 in view of Glass disclose the applicant's basic inventive concept except for making the resistivity of each sheet between 800 and about 3000 ohms. G.B. '520 fails to disclose the resistivity of the sheets but does disclose that the sheets are made from paper. Paper inherently has a high resistivity since it is an insulator. Paper would have a resistivity higher than the range specified by the applicant. Incorvia et al. discloses in column 1, lines 20-50 the idea of adding a material to a sheet in order to reduce static electricity. Increasing the surface conductivity would reduce the resistivity of the paper sheets of G.B. '520. In view of the teachings of Incorviea et al. it would have been

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obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets (which would reduce the resistivity) since this would reduce the amount of static electricity stored on the sheets and would provide a resistivity of between about 800 and about 3000 ohms. It is considered within one skilled in the art to vary the conductivity of the coating, and hence the resistivity, to reach the desired level. In regard to claim 10, the sheets of G.B. '520 are generally aligned. In regard to claims 12 and 13, Glass discloses that each sheet includes a month of the year in order, see page 1, column 2, lines 36-47. In regard to claim 14, G.B. '520 shows a backing pad (2). In regard to claim 16, Incorvia et al. discloses the idea of making the anti-static material in the form of a coating. In regard to claims 28 and 48, the steps defined are the conventional steps that are followed in using a mouse pad, i.e. locating a computer mouse onto the mouse pad, moving said mouse along the pad to cause movement of a cursor on a computer display. In regard to claims 29 and 39, G.B. teaches the idea of removing a top sheet to expose another sheet, see page 2, fourth new paragraph which starts with "Referring". In regard to claim 39, the uppermost sheet would be removed from the stack of sheets at the end of the calendar period, this is the conventional manner in which calendars of the type taught by Glass are used. In regard to claims 42 and 43, the sheets of GB '520 are made out of paper.

Claims 3,38,40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and Incorvia et al. (U.S. Patent No. 6,187,856) as applied to claim 1 above and further in view of Chasnoff (U.S. Patent No. 6,789,340) or Voy et al. (U.S. Patent No. 5,351,426) or Carpenter (U.S. Patent No. 2,030,135).

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G.B. '520 in view of Glass and Incorvia et al. disclose the applicant's basic inventive concept except for placing adhesive only on the corners of the sheets. Chasnoff shows in figures 1-5 the idea of attaching adhering components (12) only on the corners of the sheet, see column 3, lines 30-35. Voy et al. shows in figure 12 the idea of attaching adhesive (705) only on the corners of a label. Carpenter shows in figure 5 the idea of only placing adhesive (11) on the corners of a display sheet. In view of the teachings of Chasnoff or Voy et al. or Carpenter it would have been obvious to one in the art to modify G.B. '520 by placing the adhesive only in the corners of the sheets since this would allow each sheet to be grasped and removed in an easier and more convenient manner.

Claims 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) and Chasnoff (U.S. Patent No. 6,789,340) or Voy et al. (U.S. Patent No. 5,351,426) or Carpenter (U.S. Patent No. 2,030,135) as applied to claims 47 and 50 above and further in view of Incorvia et al. (U.S. Patent No. 6,187,856).

G.B. '520 does not disclose the idea of placing on the upper surface of the sheets an anti-static electric property. Incorvia et al. discloses in column 1, lines 1-20-50 the idea of adding an anti-static element to a sheet. In view of the teaching of Incorvia et al. it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets since this would reduce the amount of static electricity stored on the sheets which would help to prevent the accumulation of dust and dirt as taught to be desirable by Incorvia et al., column 1, lines 45-48.

Response to Arguments

The applicant argues that the Scianna reference discloses using the dielectric material on the bottom of the mouse pad and not on the top surface of the sheets and that the Savit reference teaches the use of a coating onto the top surface of sheets but does not relate to mouse pads. The examiner is using the Scianna and Savit references together to show the desirability of placing an anti-static coating onto the top surface of a mousepad. The Scianna reference shows that it is desirable to place an anti-static device onto a mousepad and the Savit shows that anti-static coatings can be placed on the top surface of sheets. The combination of references provides the motivation to modify G.B. '520 by attaching an anti-static coating to the top sheets of the mousepad.

The applicant argues that the commercial success of the invention as indicated in the declaration filed on June 24, 2005 is sufficient to overcome the examiner's obviousness rejections. The examiner disagrees since the applicant has still failed to show that the claimed features were responsible for the commercial success of the calendars. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996). Opinions as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. Conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight, See *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg
Jan. 9, 2006


BRIAN K. GREEN
PRIMARY EXAMINER